

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 5

### REMARKS

#### **I. Status Of The Application.**

Claims 1-18 were pending as of the date of the Office Action. In the Office Action, the Examiner:

- (a) Objected to claims 5 and 11 under 35 U.S.C. §112, second paragraph for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention;
- (b) Rejected claims 1-3, 6-9, 12-13 and 16-18 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,038,255 to Nishihashi et al. ("Nishihashi");
- (c) Rejected claims 1, 4, 8, 10, and 14-15 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,161,872 to Sasaki et al. ("Sasaki")
- (d) Rejected claims 5 and 11 under 35 U.S.C. §103(a) as allegedly being obvious over Nishihashi in view of U.S. Patent No. 6,705,745 to Pederson ("Suzuki").

Without agreeing with the grounds for the Examiner's rejection of the claims, the Applicants have canceled claims 8-18, amended claims 1-7 and added claims 19-23. The Applicants respectfully submit that the foregoing amendments and following remarks overcome the Examiner's rejections of the Application.

#### **II. The Amended Claims Do Not Constitute New Matter.**

Applicants have amended claims 1-7 and added claims 19-23 to clarify the claimed invention. Applicants respectfully submit that claims 1-7 and 19-23 are supported by the specification as originally filed in Figures 1-6 and in the detailed description of the invention at pages 2-5. Applicant has amended claims 2-7 to correct typographical errors and put the claims

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 6

into proper dependent form. Accordingly, Applicant respectfully submits that amended claims 1-7 and new claims 19-23 are supported by the specification as filed and that no new matter has been submitted by way of amendment.

**III. The Objections To 5 And 11 Under 35 U.S.C. §112, Second Paragraph, Should Be Withdrawn.**

The Applicants are not clear regarding the rejection of original claims 5 and 11 because the Examiner rejects the original claims under 35 U.S.C. §112, second paragraph, apparently based on the principle that a claim that has a broad limitation followed by a linking term and a narrow limitation within the broad limitation is indefinite. Applicants respectfully submit that original claims 5 and 11 did not have a broad limitation followed by a linking term or narrow limitation. However, in order to expedite the prosecution of this limitation, Applicants have canceled claim 11 and amended claim 5 to delete "or combination of wavelengths." Accordingly, Applicants respectfully request that the objections to claims 5 and 11 be withdrawn.

**IV. The Rejection Of Claims 1-3, 6-9, 12-13 And 16-18 Under 35 U.S.C. §102(b) As Being Anticipated By Nishihashi And The Rejection Of Claims 1, 4, 8, 10, and 14-15 Under 35 U.S.C. § 102(b) As Allegedly Being Anticipated By Sasaki Should Be Withdrawn.**

Applicant respectfully submits that neither Nishihashi nor Sasaki disclose all the limitations of amended claims 1-7 and new claims 19-23. A rejection under 102(b) can be overcome by amending the claims to patentably distinguish over the prior art. MPEP §706.02(b). Nishihashi discloses a vehicle lamp 1 that has a housing 2 with an interior surface. (Col. 2, ll. 46-55). Nishihashi discloses a film like substrate 4 with circuit patterns 41 being integrally formed on the inner surface of the housing 2 during the molding of the housing. (Col. 2, ll. 55-68). The

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 7

only other means Nishihashi discloses for forming the circuit patterns 41 on the lamp housing is by printing the circuit patterns 41 on the molded housing 2. (Col. 3, ll. 6-9).

Nishihashi does not disclose all the limitations of amended independent claim 1 and new independent claim 19. For example, Nishihashi does not disclose "a lamp assembly comprising . . . a conductive lead frame insert molded into the housing, the conductive lead frame being encapsulated by the housing," as claimed in claim 1. "Insert molding", as used in the Application and herein, is an injection molding process whereby an insert piece that is desired to be encapsulated in a molded product is inserted into a molding cavity so that once plastic resin is injected into the molding cavity to form the product, the plastic resin will flow around and encapsulate the insert piece. The result of insert molding is a single product with the insert piece being encapsulated by the plastic to some desired extent. Nishihashi does not disclose "a conductive lead frame insert molded into the housing, the conductive lead frame being encapsulated by the housing." Rather, Nishihashi discloses a **film like substrate** with a circuit pattern **being placed on the interior surface** of the lamp housing or alternatively, forming the circuit pattern by **printing the circuit pattern on the surface of the housing**. Accordingly, Applicants respectfully submit that amended claim 1 and claims 2-7 and 23, which depend therefrom, are not anticipated by Nishihashi because nothing in Nishihashi discloses, teaches or suggests a conductive lead frame insert molded into and encapsulated by the housing.

Moreover, Nishihashi does not disclose all the limitations of new claims 19-22. For example, Nishihashi does not disclose "[a] method for manufacturing a lamp assembly . . . comprising the steps of . . . inserting the conductive lead frame into a molding cavity . . . (and) molding a housing . . . around the lead frame in the molding cavity by injecting a

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 8

plastic resin into the molding cavity, so that the conductive lead frame is encapsulated by the housing," as claimed in new independent claim 19. As explained above, Nishihashi only discloses placing a film substrate with a circuit pattern on the interior surface of the housing or in the alternative, printing a circuit pattern on the surface of the housing. Thus, Nishihashi does not disclose, teach or suggest "molding a housing around the lead frame" as claimed in independent claim 19. Accordingly, Applicants respectfully submit that the rejection of the claims under 35 U.S.C. §102(b) as being anticipated by Nishihashi should be withdrawn because Nishihashi does not disclose, teach or suggest all the limitations of independent claim 19 or all the limitations of claims 20-22 which depend from claim 19.

Similarly, the rejection of the claims under 35 U.S.C. § 102(b) as being anticipated by Sasaki should be withdrawn because Sasaki does not disclose all the limitations of amended claims 1-7 and new claims 19-23. Sasaki discloses a lead frame 2 for an indicator needle 1 of an automotive instrument. (Col. 1, ll. 1-20; Col. 2, ll. 1-11). LED chips 51 and 54 are bounded onto portions 201 to 204 on the upper surface of the lead frame 2. (Col. 2, ll. 11-20). Lead frame 2 is inserted into base 3 of the indicator needle so that the lead frame 2 is arranged on the bottom 3a of the LED chip accommodating part of the base 3. (Figs. 3-4, Col. 2, ll. 29-40; Col. 3, ll. 5-13). Sasaki's lead frame is just like all other prior art printed circuit boards that are inserted and attached to a surface, in this case base 3 of indicator needle 1.

Nothing in Sasaki discloses all the elements of amended independent claim 1 or new independent claim 19. For example, Sasaki does not disclose "a lamp assembly comprising . . . a conductive lead frame insert molded into the housing, the conductive lead frame being encapsulated by the housing," as claimed in claim 1. Nor does Sasaki disclose "[a] method for

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 9

manufacturing a lamp assembly . . . comprising the steps of . . . inserting the conductive lead frame into a molding cavity . . . (and) molding a housing . . . around the lead frame in the molding cavity by injecting a plastic resin into the molding cavity, so that the conductive lead frame is encapsulated by the housing," as claimed in new independent claim 19. Accordingly, Applicants respectfully submit that the rejection of the claims under 35 U.S.C. §102(b) as being anticipated by Sasaki should be withdrawn because Sasaki does not disclose, teach or suggest all the limitations of independent claims 1 and 19 or all the limitations of claims 2-7, 23 and 20-22 which depend from claims 1 and 19, respectively.

**V. The Rejections Of Claims 5 And 11 Under 35 U.S.C. §103(a) As Being Obvious Over Nishihashi In View Of Pederson Should Be Withdrawn.**

Applicants respectfully submit that the rejections of claims 5 and 11 should be withdrawn because Applicants have canceled claim 11 and have amended independent claim 1 from which claim 5 depends. "To establish prima facie obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art." MPEP 2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)). Further, "[i]f an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing *In re Fine*, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

As explained above, Nishihashi does not disclose, teach or suggest "a lamp assembly comprising . . . a conductive lead frame insert molded into the housing, the conductive lead frame being encapsulated by the housing," as claimed in claim 1. Moreover, Pederson does not disclose, teach or suggest "a lamp assembly comprising . . . a conductive lead frame insert molded into the housing, the conductive lead frame being encapsulated by the housing." as

Commissioner of Patents  
Serial No. 10/656,542  
Amendment Date March 15, 2005  
Reply to Office Action dated December 15, 2004  
Page 10

claimed in claim 1. Nor does the Examiner assert that Pederson discloses, teaches or suggests these limitations of claim 1. Accordingly, Applicants respectfully submit that the rejection of claim 5 under 35 U.S.C. §103(a) should be withdrawn because claim 5 depends from and incorporates all of the limitations of allowable independent claim 1.

### CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that Applicants have made a patentable contribution to the art. Favorable reconsideration and allowance of this Application is therefore respectfully requested. In the event Applicants have inadvertently overlooked the need for payment of an additional fee, Applicants conditionally petition therefore, and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

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Enclosures: Facsimile Cover Sheet